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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,880	07/09/2001	Jae-Ryung Lee	EF321684167U	4381

21003 7590 06/13/2003

BAKER & BOTTS  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER
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AHMED, SHEEBA

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 06/13/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/869,880	LEE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sheeba Ahmed	1773	

-- The MAILING DATE of this communication appears in the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 October 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Amendment*

1. Amendments to the Abstract and Figure 1 have been entered in the above-identified application. **Claims 1-4 are pending.**

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. (WO 00/32843) in view of Dickie et al. (US 3,987,127).

Lee et al. disclose a surface-treated steel sheet for fuel tanks wherein the steel sheet is cold-rolled and has a zinc or zinc-based alloy plating layer formed on the steel sheet and a chromate film coated on the zinc or zinc-based plating layer which is then coated with a resin coating layer. The resin-coating layer may be formed on one side or both sides of the chromate film and comprises a phenoxy resin solution having a molecular weight of 25,000 to 50,000, 10-20 phr of colloidal silica, and 2-15 phr of melamine resin (Page 3, lines 1-20). The coating layer may be applied by roll coating (Page 6, lines 16-20) and is baked at 160-250°C to harden the resin coating layer (Page 12, lines 17-20). The thickness of the resulting resin-coating layer is between 1 to 10 microns (Page 12, lines 11-12).

Lee et al. do not specifically teach that the resin coating layer contains 0.5 to 3.0 phr of phosphoric ester.

However, Dickie et al. disclose polymerizable coating compositions which are particularly suited as corrosion or abrasion resistant protection coatings for metal surfaces (Column 1, lines 15-20) and comprise 0.05 to 1.0 phr of mono- or diesters of phosphoric acid (Column 1, lines 63-66). The coating compositions provide an excellent protective surface which adheres well to metals (Column 2, lines 15-20).

Accordingly, the Examiner takes the position that it would have been obvious to one having ordinary skill in the art to add 0.5 to 1.0 phr of a phosphoric acid ester to the composition disclosed by Lee et al. given that Dickie specifically teaches that doing so improves the adhesion between the coating and a metal substrate.

### ***Response to Arguments***

3. Applicant's arguments filed on October 10, 2002 (Paper No. 6) have been fully considered but they are not persuasive. Applicants traverse the rejection of claims 1-4 under 35 U.S.C. 103(a) as being unpatentable over Lee et al. (WO 00/32843) in view of Dickie et al. (US 3,987,127) and submit that because of the priority claim to Korean Application Serial No. KR 1999/50110, filed on November 12, 1999, the disclosure of Lee et al. no longer serves as a prior art reference with respect to the present application. Applicants further argue that Dickie et al. is not relevant to the instant invention given that it involves the addition of corrosion resistance and abrasion resistance to metal surfaces used for trim or brightwork on the exterior of an automobile

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whereas the present invention deals with cosmetic corrosion resistance of the fuel tank of an automobile.

However, the Examiner disagrees. First, Applicants priority claim to Korean Application Serial No. KR 1999/50110, filed on November 12, 1999, has not been perfected. Applicants are reminded that the filing date of the priority document is not perfected unless Applicants have filed a certified priority document in the application **and an English language translation, if the document is not in English** (see 37 CFR 1.55(a)(3)) and the Examiner has established that the priority document satisfies the enablement and description requirements of 35 U.S.C. 112, first paragraph. Second, the Examiner maintains that Dickie et al. is in fact relevant to the instant invention. Applicant's are reminded that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Dickie et al. specifically disclose polymerizable coating compositions comprising 0.05 to 1.0 phr of mono- or diesters of phosphoric acid which are particularly suited as corrosion or abrasion resistant protection coatings for metal surfaces wherein the coating compositions provide an excellent protective surface which adheres well to metals. Hence, Dickie et al. is pertinent to the particular problem with which the applicant was concerned.

### **Conclusion**

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4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (703)305-0594. The examiner can normally be reached on Mondays and Thursdays from 8am to 6pm.

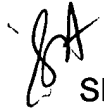
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703)308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-5408 for regular communications and (703)305-3599 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)306-5665.



Sheeba Ahmed  
June 11, 2003